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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/419,592 10/18/99 LANDS

M 2176

EXAMINER

QM32/0818

NEIL D GERSHON ESQ
UNITED STATES SURGICAL CORPORATION
150 GLOVER AVENUE
NORWALK CT 06856

ART UNIT A

PAPER NUMBER

3731
DATE MAILED:

08/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/419,592

Applicant(s)

Lands et al.

Examiner

Anthony S. King

Group Art Unit

3731



☒ Responsive to communication(s) filed on Oct 18, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-30 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7, 18 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Having the jaw members “filleted” was not sufficiently described in the specification.

3. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner is of the opinion that it would be physically impossible for the two inner facing surface of the jaw members to be complimentary to eachother if the disposition of the waveforms are different.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 recites the limitation "improvement" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

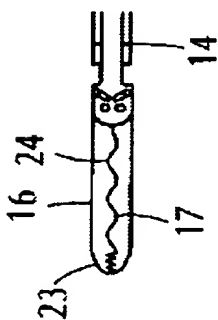
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Buysee et al. (5,776,130).

Buysee et al. disclose in figures 2 and 3 an electrosurgical instrument comprising obviously jaw



members with waveform opposing inner facing surfaces (part 17), distal manipulating portion, and complimentary clamping portion.

An anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each

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and every element of a claimed invention. See RCA Corp v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984).

It is well settled that the law of anticipation does not require that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal “read on” something disclosed in the reference, i.e., all limitations of the claims are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word or word as in the rejected claim so long as the reference inherently discloses that element or limitation. See, for example, Standard Havens Products, Inc. v. Gencor Industries, Inc., 953 F.2d 1360, 21 USPQ 2d 1321 (Fed. Cir. 1991).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 3, 5, 6, 8-17, 19-25, 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buysse et al. (5,776,130) in view of Lands et al. (6,090,109), Azonian et al. (6,083,150), and Francese et al. (5,553,624).

With respect to claim 3, Buysee et al. disclose substantially all of the claimed limitations except for a clamping portion that is wider than the manipulating portion. Lands et al. teaches a electrosurgical instrument having a clamping portions (fig. 2, parts 39 and 40) that are wider than manipulating portions (37, 38) for the purpose of easier manipulation of the distal tip (as it is common in clamps, graspers, needle holders to have a tapered, narrowed tip). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was

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made, to modify the forceps disclosed by Buysee et al. with teachings of Lands et al. to provide a narrowed manipulating portion.

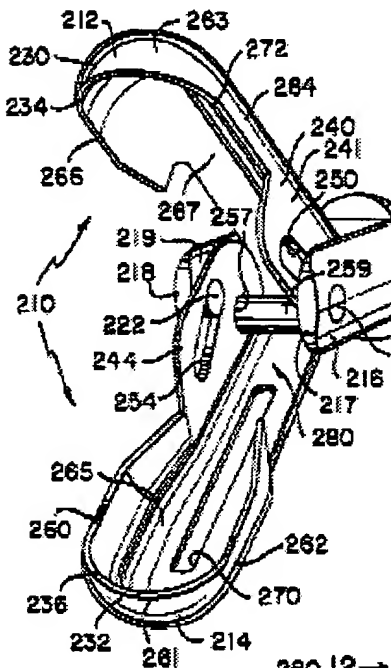
In regard to claims 5, 6, 16 and 17, Buysee et al. does not disclose transversal disposition of the wave forms. It would have been an obvious matter of design choice to change the orientation of the wave form on the inner surface of the jaw members, since applicant has not disclosed that having transversely disposed or a combination of transversely disposed and longitudinally disposed solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with having the wave form longitudinally disposed as in Buysee et al.

In regard to claims 8-10, Buysee et al. discloses the claimed invention except for the limitations of non-stick coating, non-conductive inner facing surfaces, and semi-conductive inner facing surfaces. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide these variations of surface treatment and material conductivity since it was known in the art that bipolar and monopolar electrosurgical instruments of this type would have such varied properties.

With regard to claims 11-13, 22 and 23, Buysee et al. disclose a bipolar electrosurgical instrument having two electrical potentials but does not disclose having at least one fenestration disposed on jaw member. Francese et al. and Aznoian et al. teach endoscopic forceps having at least one fenestration on jaw members. (See part 37, figure 5 of Francese et al, and parts 270 and

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272, figure 11 of Azonian et al. Below is a excerpt of Azonian's motivation for such fenestrations: (beginning from column 11, line 48)



"The fenestration 270, 272 serves two purposes. First, the fenestration 270, 272 permits fluids to drain from collected samples (not shown). Second, the fenestration 270, 272 tends to grip each tissue sample, a portion of which is squeezed into the fenestration when the jaws are closed to sever the sample from a tissue mass. As successive samples are collected in the tissue sample storage area 280, previously

collected samples are pushed deeper into the sample storage area 280. The successively collected samples are indexed along the fenestration in the order that they are collected, facilitating later analysis, and the samples are retained with sufficient force to prevent premature loss of individual samples from the jaw assembly. Each fenestration 270, 272 in this particular embodiment is slightly tapered such that the fenestration is narrower toward the distal end of the jaw, and wider toward the proximal end of the jaw. This

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slight taper is provided to facilitate the sliding movement of tissue samples deeper into the tissue sample storage area 280 as successive tissue samples are collected. “

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made, to modify the forceps disclosed by Buysee et al. with teachings of Azonian et al. and provide fenestrations for the aforementioned purposes.

As for claim 14, see rejection to claim 2.

As for claim 15, see rejection to claim 4.

As for claims 19-21, see rejections to claims 8-10.

With respect to claim 24, bipolar electrosurgical instruments such as one disclosed by Buysee et al. would inherently have the two electrodes vertically align with one another since the entire length of the inner facing jaw members are become the electrodes when coagulation is in action.

As for claim 25, see rejection to claim 2.

As for claim 27, see rejection to claim 3.

As for claims 28-30, see rejection to claims 8-10.

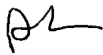
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony S. King whose telephone number is (703) 306-5962. The examiner can normally be reached Mon-Fri., 8:00 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Buiz, can be reached at (703) 308-0871.

General inquiries relating to the status of this application should be directed to the Group receptionist at (703) 308-0858. The FAX number is (703) 305-3579.



Anthony S. King

Patent Examiner



MICHAEL BUIZ
SUPERVISORY PATENT EXAMINER
GROUP 3300

8/15/00

August 15, 2000